

# EXHIBIT 40



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(for Patent Owner)

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(for Third Party Requester)

*In re Cabilly et al*  
Reexamination Proceeding  
Control No.: 90/007,542  
Filed: May 13, 2005  
For: U.S. Patent 6,331,415

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REEXAM UNIT

DECISION MERGING  
REEXAMINATION  
PROCEEDINGS

*In re Cabilly et al*  
Reexamination Proceeding  
Control No.: 90/007,859  
Filed: December 23, 2005  
For: U.S. Patent 6,331,415

The above noted reexamination files are before the Director of the Central Reexamination Unit for consideration of the proceedings under 37 C.F.R. 1.565(c).

**BACKGROUND**

1. United States Patent 6,331,415, issued December 18, 2001, is the subject of Reexamination Control Nos. 90/007,542 and 90/007,859.
2. A first request for reexamination, assigned Reexamination Control No. 90/007,542, was filed May 13, 2005 by Lisa V. Mueller, of Wood, Phillips in Chicago IL. The request urged that a substantial new question of patentability was raised by the teachings of USPN 4,816,567.
3. Reexamination was ordered for 90/007,542 on May 13, 2005.

4. A first Office action for 90/007,542 was mailed September 13, 2005.
5. A Patent Owner response was submitted on November 25, 2005.
6. A second request for re-examination, assigned Reexamination Control No. 90,007,859, was filed December 23, 2005 by Elliot M. Olstein of Carella, Byrne in Roseland New Jersey. The request urged that a substantial new question of patentability was raised by USPN 4,816,567 alone or in combination with several NPL documents.
7. Reexamination was ordered for 90/007,859 on December 23, 2005. There has been no Patent Owner response.

## DISCUSSION

Under 37 C.F.R. 1.565(c):

If *ex parte* reexamination is ordered while a prior *ex parte* reexamination proceeding is pending and prosecution in the prior *ex parte* proceeding has not been terminated, the *ex parte* reexamination proceedings will be consolidated and result in the issuance of a single certificate under para 1.570.

As noted in the above review of facts, reexamination has been ordered in each of the above reexamination proceedings. Accordingly, merger of the proceedings under 37 C.F.R. 1.5659 (c) is appropriate. MPEP 2283 further sets forth:

If the second request is based upon essentially the *same* patents or publications as in the first request or on patents or printed publications which raise essentially the same issues as those raised in the first request, and if reexamination is ordered, the examination of the merged proceeding will continue at the point reached in the first reexamination proceeding. If, however, *new* patents or printed publications are presented in the second request which raise different questions than those raised in the first request, then prosecution in the merged reexamination proceeding will be reopened, if applicable, to the extent necessary to fully treat the question raised.

## DECISION

### I. MERGER OF PROCEEDINGS

In accordance with 37 C.F.R. 1.565(c), the 90/007,542 and 90/007,859 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

### II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

Patent owner is required to maintain the same claims (and specification) in both files throughout the merged proceeding. Since the claims are the same in both files, a "housekeeping amendment" is NOT needed. See MPEP 2283, "Merger of Reexaminations."

### III. CONDUCT OF MERGED PROCEEDING

All papers mailed by the Office throughout the merged proceeding will take the form of a single action which applies to all proceedings. All papers issued by the Office or filed by the Patent Owner will contain the identifying data for all files and will be physically entered in each reexamination file. All papers filed by the Patent Owner must consist of a single response, **filed in duplicate**, each bearing a signature and identifying data for all files, for entry into each file.

All correspondence from the USPTO will be addressed to the patent owner's representative address listed in Reexamination Control Nos. 90/007,542 and 90/007,859 as:

Wendy M. Lee  
Genentech, Inc.  
1 DNA Way  
South San Francisco, CA 94080-4990

A copy of all correspondence from the USPTO will be served on the third party requester at the address listed in Reexamination Control No. 90/007,542 as:

Lisa V. Mueller  
Wood, Phillips, Katz, Clark & Mortimer  
3800 West Madison Street, Suite 3800  
Chicago, IL 60661

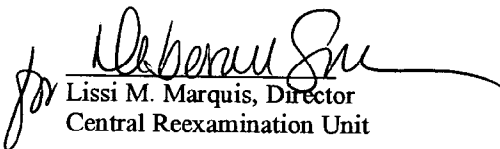
A copy of all correspondence from the USPTO will be served on the third party requester at the address listed in Reexamination Control No. 90/007,542 as:

Elliot M. Olstein  
Carella, Byrne, Bain, Gilfillan, Cecchi, Stewart & Olstein  
5 Becker Farm Road, 2<sup>nd</sup> Floor  
Roseland, New Jersey 07068

## CONCLUSION

Reexamination Control Nos. 90/007,158 and 90/007,712 are merged. The re-examination files shall be forwarded to the examiner for action in due course.

Any inquiry concerning this decision should be directed to Deborah Jones, Special Programs Examiner, at telephone No. (571) 272-1535.

  
Lissi M. Marquis, Director  
Central Reexamination Unit